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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,992	03/24/2004	Rainer Schoenfeld	H 50058 HST	7745
423	7590	05/21/2007		
HENKEL CORPORATION THE TRIAD, SUITE 200 2200 RENAISSANCE BLVD. GULPH MILLS, PA 19406			EXAMINER SELLERS, ROBERT E	
			ART UNIT	PAPER NUMBER
			1712	
			MAIL DATE	DELIVERY MODE
			05/21/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/808,992

Applicant(s)

SCHOENFELD, RAINER

Examiner

Robert Sellers

Art Unit

1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 2-5, 7, 11, 12, 14-17, 23 and 25-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 6, 8-10, 13, 18-22, 24 and 30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

Art Unit: 1712

1. Claims 25-29 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Claims 2-5, 7, 11, 12, 14-17 and 23 are withdrawn as being directed to non-elected species. The elections have been made without traverse in the non-Final rejection mailed June 23, 2006.

2. The 35 U.S.C. 102(b) rejection over Japanese Patent No. 4,89840 and the 35 U.S.C. 103(a) rejection involving Takahashi et al. Patent No. 5,885,723 and Rieder et al. Patent No. 4,172,802 are withdrawn in response to the limitation of the structure in independent claim 1 to X being -S- or -NR²- and excluding -O- which is the terminal OH group(s) of the reaction products of the references.

The text of section 103(a) of Title 35, U.S. Code not included in this action can be found in the non-Final rejection mailed June 23, 2006.

Claims 1, 6, 8-10, 13, 18-22, 24 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Speranza et al. Patent Nos. 5,093,382 (Speranza et al. '382) and 5,128,441 (Speranza et al. '441).

3. The rejection involving Speranza et al. '382 has been converted from a 35 U.S.C. 102(b) rejection since the newly claimed absence of imide groups (supported by page 4, line 15 of the specification) is not recited.

Nowhere in the descriptions of the reaction product of a polyoxyalkylene polyamine and a polycarboxylic acid anhydride such as trimellitic anhydride in Speranza et al. '382 (col. 14, lines 38-55 and col. 15, lines 43-44, Product F) and Speranza et al. '441 (col. 5, lines 7-45 and col. 6, lines 48-49) is there any indication that imide groups are formed.

The declaration and arguments filed May 7, 2007 have been considered but are unpersuasive.

4. There is no empirical evidence of record that the reaction product shown in Product F of Speranza et al. '382 (the closest prior art reaction product) contains any imide groups. The allegations in paragraphs 5 and 6 on pages 2 and 3 of the declaration that the reaction temperatures of from about 150°C to about 250°C in the Speranza et al. patents and the acid value of 0.803 meq/g for the reaction product of Speranza et al. '382 establishes the presence of imide formation are merely opinions uncorroborated by any showings. Speranza et al. '441 in column 5, lines 39-45 states:

"This will insure [sic] that the carboxylic acid, ester or anhydride thereof will be joined to the polyamine through an **amide linkage** to thereby provide an intermediate condensation product that is substantially completely free from terminal primary amine groups and that is characterized by the presence of terminal carboxylic acid, anhydride or ester groups [emphasis added]."

Accordingly, Speranza et al. '441 employing the same reactants and reaction conditions as that of Speranza et al. '382 affirmatively defines the presence of amide groups, not imide groups, in the reaction product.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Sellers whose telephone number is (571) 272-1093. The examiner can normally be reached on Monday to Friday from 9:30 to 6:00. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).



Robert Sellers
Primary Examiner
Art Unit 1712